

**Notice of Allowability**

Application No.

09/497,552

Examiner

Evelyn A. Lester

Applicant(s)

OLIVA, GUIDO MAURIZIO

Art Unit

2873



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 7-19-05.
2. ☒ The allowed claim(s) is/are 1,2,4-8 and 10-39.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).


\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_



EVELYN LESTER  
PRIMARY EXAMINER

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 2, 4, 5, 11-15, 26, 29 and 32-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6-14 and 17 of copending Application No. 09/773,384 (which is also

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published application number US 2002/0050517 A1, filed on February 1, 2001).

Although the conflicting claims are not identical, they are not patentably distinct from each other because each claimed invention of the applications is merely a variation of the other, wherein one invention would anticipate the other.

Each claimed invention recites an optical device, wherein a laser light beam is focused by a focusing lens and a first means or a diaphragm, directly on the focusing lens (claim 1 of the instant invention and claim 13 of the other application's claimed invention) which selects only a central portion of the laser beam, and further wherein the first means or diaphragm defines an aperture having a Fresnel number less than 2. The copending application's claimed invention further describes a source of a laser light beam. However, this is inherent to the present claimed invention, which claims a laser beam. One of ordinary skill in the art would know to provide a source of laser light to provide the appropriate laser beam for the claimed optical device.

This is a **provisional** obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

However, because this is a provisional obviousness-type double patenting rejection and this is the only remaining rejection in the case, this rejection is effectively hereby withdrawn, and the application is deemed in condition for allowance.

## **REASONS FOR ALLOWANCE**

2. The following is an examiner's statement of reasons for allowance:

The prior art does not show or fairly suggest the claimed invention of an optical device/element for focusing a laser beam, a lens for focusing the laser beam, and an apparatus and method for assembling an optical device for focusing a laser beam, having the claimed structure and claimed limitations, wherein a rejection under 35 USC 102 or 103 would be improper. Please particularly note the combination of claimed elements and claimed limitations, including the reasons for indicating allowable subject matter given in the office action mailed on 4-19-2005, pages 6-7, paragraph 9. Please also note the reasons for allowance given in the office action mailed on 9-16-2003, regarding claims 9, 10, 30 and 31, at pages 8-9, paragraph 10, wherein the subject matter is now incorporated into independent claim 1 and claims 30 and 31 are now independent claims (claim 10 is amended to be dependent on claim 1).

The claimed invention further includes: as recited in independent claim 27, a lens for focusing a laser beam having a coating means made of a substantially opaque material, applied to the peripheral portion of the front surface of the lens so as to allow the propagation of a central portion of the laser beam and obstruct the propagation of a surrounding portion of the beam, wherein the coating means defines on the focusing lens an aperture having a Fresnel number which is smaller than 2 along the fixed reading direction; as recited in independent claim 29, an optical element having a focusing lens adapted to allow the propagation of a central portion of the laser beam and in the surrounding portion of the lens means adapted to separate the central portion

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of the laser beam from the surrounding portion, wherein the means defines on the focusing lens an aperture having a Fresnel number which is smaller than 2 along the fixed reading direction and wherein the means is integral with the focusing lens to form a single optical element; as recited in independent claim 32, an optical device for focusing a laser beam having a single optical element, which single optical element comprises a focusing lens and a first means arranged "around" an outer edge of the focusing lens to separate a central portion of the laser beam from the surrounding portion of the laser beam, wherein the "entire portion of the laser beam collecting by the focusing lens is focused"; as recited in independent claim 38, an optical device for focusing a laser beam, having a single optical element, which comprises a focusing lens and a first means in the surrounding portion of the optical element and around an outer edge of the focusing lens adapted to separate the central portion of the laser beam from the surrounding the portion of the laser beam, further wherein the first means and the focusing lens being distinct from one another and being arranged in the single optical element such that they are never adjacent (this is construed as meaning always one element, and not separate from each other, as in integral) along any direction of propagation of the laser beam within the single optical element and the entire portion of the laser beam collected by the focusing lens is focused; and as recited in independent claim 39, an optical device for focusing the laser beam, having a single optical element, which comprises a focusing lens and a first means in the surrounding portion of the optical element and around an outer edge of the focusing lens adapted to separate the central portion of the laser beam from the surrounding the portion of the laser beam,

and the entire portion of the laser beam collected by the focusing lens is focused, and further wherein the first means defines on the focusing lens an aperture having a Fresnel number which is smaller than 2 along the fixed reading direction.

Therefore, in light of the Applicants' arguments and amendments, the claimed invention is considered to be in condition for allowance as being novel and nonobvious over the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Response to Arguments***

3. Applicant's arguments filed 12-15-04 have been fully considered and they are deemed persuasive, in light of the amendments made to the claims.


Regarding the provisional obviousness-type double patenting rejection, this rejection is proper and hereby maintained. The application is now in condition for allowance, except for the obviousness-type double patenting rejection. Therefore the obviousness-type double patenting rejection is hereby withdrawn, as it is the only remaining rejection in the application, and the rejection is based on another U.S. patent application, which is still an application.

***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (571) 272-2332. The examiner can normally be reached on subject to an increased flex schedule, M-F, 10-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Evelyn A. Lester  
Primary Examiner  
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